

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

20w
AR

Appellant: Jason May et al.

Title: METHOD AND APPARATUS FOR FACILITATING ONLINE PAYMENT TRANSACTIONS IN A
NETWORK-BASED TRANSACTION FACILITY USING MULTIPLE PAYMENT INSTRUMENTS

Docket No.: 2043.016US1
Filed: May 22, 2000
Examiner: Charles Kyle



Serial No.: 09/577,434
Due Date: August 27, 2006
Group Art Unit: 3624

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

We are transmitting herewith the following attached items (as indicated with an "X"):

- ☒ Appellants' Reply Brief Under 37 CFR 41.41 (4 pgs.).
- ☒ Return postcard.

Please consider this a **PETITION FOR EXTENSION OF TIME** for sufficient number of months to enter these papers and please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
Customer Number 49845

By: Andrew DeLizio
Atty: Andrew DeLizio
Reg. No. 52,806

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 24 day of August, 2006.

Peter Rebuffoni
Name

Peter Rebuffoni
Signature



S/N 09/577,434

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Jason May et al.

Examiner: Charles Kyle

Serial No.: 09/577,434

Group Art Unit: 3624

Filed: May 22, 2000

Docket: 2043.016US1

Title: METHOD AND APPARATUS FOR FACILITATING ONLINE PAYMENT
TRANSACTIONS IN A NETWORK-BASED TRANSACTION FACILITY
USING MULTIPLE PAYMENT INSTRUMENTS

APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This brief is presented in response to the Examiner's Answer, dated June 27, 2006, which was sent in answer to Appellants' Brief, filed on February 28, 2006. Appellants' Brief on Appeal was filed in response to the final rejection of pending claims 1-25 of the above-identified patent application.

Please charge any required additional fees or credit overpayment to Deposit Account No. 19-0743.

APPELLANTS' REPLY

The Examiner's Answer Brief ("the Answer"), dated June 27, 2006 includes substantially identical grounds for rejection as the last Final Office Action. The Appellants have reviewed the Answer, and believe the statements in the original Appeal Brief remain accurate and compelling.

In responding to the Answer, the Appellants will further discuss issues raised in the Answer. In particular, Appellant will show that there is no teaching or suggestion to combine the cited references.

THERE IS NO TEACHING OR SUGGESTION TO COMBINE EGENDORF AND EBAY

In the Answer and throughout prosecution, the Examiner rejected Appellants' claims based on a combination of Egendorf and *eBay*. Claim 1 recites a computer-implemented "risk analysis to determine whether the second participant is qualified to use a payment instrument selected by the second participant from the at least one payment instrument acceptable to the first participant," where the risk analysis uses feedback "pertaining to the second participant and including information provided by peers of the second participant."

Appellants submit that the Examiner's combination of Egendorf and *eBay* does not teach or suggest each and every element of the rejected claims.¹ Furthermore, even if it did (which the Appellants deny), the Examiner has not provided a teaching or suggestion from the prior art that would motivate one of ordinary skill in the art to modify Egendorf based on *eBay*. In the Answer, the Examiner asserts that *eBay* discloses "that a risk analysis is done using feedback information provided by peers of the second participant at pages 31-35." The Examiner also asserts, "It would have been obvious... to modify Egendorf with the risk analysis using feedback

¹ For more the complete discussion, see Appellant's Appeal Brief at pages 9-11.

information provided by peers of the second participant of eBay because this would provide information related to the participant's reliability and likelihood of prompt payment."²

Appellants submit that the Examiner must have used impermissible hindsight when forming the cited combination. According to *eBay*, users provide and view feedback and use it as a track record for parties with whom they may enter transactions.³ However, *eBay* does not suggest modifying transaction systems to use feedback as part of a computer-implemented risk analysis. More importantly, *eBay*'s feedback does not relate to determining whether participants are qualified to use certain payment instruments. Because *eBay*'s feedback neither relates to an automated risk analysis nor to decisions about payment instruments, *eBay* does not teach or suggest the cited combination. Appellants believe the Examiner used Appellants' claims as a roadmap for the cited combination. If the combination were not based on hindsight, the Examiner would have identified at least one passage from Egandorf, *eBay*, or some other reference that would suggest modifying Egandorf. However, any such passages are conspicuously absent from the record. As such, Appellants submit that the Examiner has not made a *prima facie* case of obvious vis-à-vis the rejected claims.

² *Id.*

³ *eBay* at 31-32.

CONCLUSION

Appellants respectfully submit the claimed invention is patentable over the cited art.
Reversal of the claim rejections is respectfully requested.

Respectfully submitted,

JASON MAY ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
281-213-8980

Date August 24, 2006 By Andrew DeLizio
Andrew DeLizio
Reg. No. 52,806

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 24 day of August 2006.

Peter Ruffoni
Name

Peter Ruffoni
Signature